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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/581,002 | 08/20/2007 | Martin Scheffel | 10191/4261 | 8318 |

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| EXAMINER |
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GIMIE, MAHMOUD

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| ART UNIT | PAPER NUMBER |
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3747

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10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/581,002 | Applicant(s) SCHEFFEL ET AL. | |
| | Examiner Mahmoud Gimie | Art Unit 3747 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/26/2006; 3/24/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Akutagawa et al. (US 5,893,351).

Akutagawa et al. disclose a support element for mutually supporting a fuel injector in a valve receptacle of an intake manifold of an internal combustion engine, as well as mutually supporting the fuel injector against a fuel distribution line, comprising: a clamp body (50); at least two clips (51b, 52a, 53a) extending from the clamp body and configured to interact with one of the fuel injector and the fuel distribution line; and at least two brackets (53b) extending axially from the clamp body and configured to interact with one of the fuel injector and the fuel distribution line.

Note: mounting the fuel injector in a cylinder head instead of an intake manifold is an intended use and does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte Masham, 2 USPQ2d 1647 (1987)). Consequently, it was not given patentable weight.

Regarding claim 24, wherein the brackets rest against a shoulder of the fuel distribution line.

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Regarding claim 25, wherein the clips rest against a shoulder of the fuel injector.

Regarding claim 26, wherein the brackets (53b) rest against a shoulder of the fuel injector.

Regarding claim 27, wherein the clips rest against a shoulder of the fuel distribution line.

Regarding claim 28, wherein the number of brackets (53b) is exactly two.

Regarding claim 29, wherein the number of clips (53a) is exactly two.

Regarding claim 30, wherein the clips (53a) radially grasp the fuel injector.

Regarding claim 31, wherein the number of clips is three (51b).

Regarding claim 32, wherein the three clips have the same shape.

Regarding claim 33, wherein the three clips each have at least one curve.

Regarding claim 34, wherein the clips have different shapes.

Regarding claim 35, wherein two of the three clips have the same shape.

Regarding claim 36, wherein at least one of the three clips has a tongue shape.

Regarding claim 37, wherein at least one of the three clips has an onion shape.

Regarding claim 38, wherein the at least one clip having an onion shape has a hole.

Regarding claims 39-44, the claimed subject matter is substantially the same as the above rejected claims.

3. Claims 23-44 are rejected under 35 U.S.C. 102 (e) as being anticipated by Braun ET al (6,830,037).

Braun et al. disclose a support element for mutually supporting a fuel injector in a valve receptacle of a cylinder head of an internal combustion engine, as well as mutually supporting the fuel injector against a fuel distribution line, comprising: a clamp body

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(40); at least two clips (36) extending from the clamp body and configured to interact with one of the fuel injector and the fuel distribution line; and at least two brackets (50) extending axially from the clamp body and configured to interact with one of the fuel injector and the fuel distribution line; see figures 1 and 2.

Regarding claim 24, wherein the brackets rest against a shoulder of the fuel distribution line; see figures 1 and 2.

Regarding claim 25, wherein the clips rest against a shoulder of the fuel injector.

Regarding claim 26, wherein the brackets (50) rest against a shoulder of the fuel injector.

Regarding claim 27, wherein the clips (36) rest against a shoulder of the fuel distribution line.

Regarding claim 28, wherein the number of brackets (50) is exactly two.

Regarding claim 29, wherein the number of clips (36) is exactly two.

Regarding claim 30, wherein the clips (36) radially grasp the fuel injector.

Regarding claim 31, wherein the number of clips is three; see figures 3-5.

Regarding claim 32, wherein the three clips have the same shape; see figures 3-5.

Regarding claim 33, wherein the three clips each have at least one curve.

Regarding claim 34, wherein the clips have different shapes.

Regarding claim 35, wherein two of the three clips have the same shape.

Regarding claim 36, wherein at least one of the three clips has a tongue shape.

Regarding claim 37, wherein at least one of the three clips has an onion shape.

Regarding claim 38, wherein the at least one clip having an onion shape has a hole.

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Regarding claims 39-44, the claimed subject matter is substantially the same as the above rejected claims.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23-44 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 7,210,462.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the current application is broader in some respect and merely adds obvious features in other respects.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose fuel injector clips.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahmoud Gimie whose telephone number is 571-272-4841. The examiner can normally be reached on Monday-Friday between 7 a.m. -3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen K. Cronin can be reached on 571-272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MG/

/Mahmoud Gimie/

Primary Examiner, Art Unit 3747